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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,073	02/15/2001	Yoshinori Ito	35.C15126	3810
5514	7590	12/28/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			HEWITT II, CALVIN L	
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NEW YORK, NY 10112			PAPER NUMBER	

3621

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,073

Applicant(s)

ITO, YOSHINORI

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 13, 14, 16 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 13, 14, 16 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-6, 8, 13, 14, 16 and 33-37 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6, 8, 13, 14, 16 and 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "specified" in claims 1, 14, 16, 33, 36 and 37 is a relative term which renders the claim indefinite. The term "specified" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 2-5, 8, 13, 34, and 35 are also rejected as they depend from claims 1, 14, or 33.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-7, 14, 16, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Srinivasan, U.S. Patent No. 6,460,076.

As per claims 1, 3, 5, 7, 14, 16, and 33-37, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering predetermined information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)
- information such as information that specifies credit card company and credit card user (column 5, lines 25-32)
- first input means for entering information for enabling activation (column 5, lines 60-66) and second input means also for enabling

activation in response to the entering of enabling information
(abstract)

- discrimination means for discriminating whether said image is a specified image and control means for controlling the addition by said addition means based on the result of discrimination by discrimination means (column 5, lines 25-58)
- inquiry means for authenticating predetermined information by communicating through a communication channel with an external server (column 5, lines 32-44)

Regarding “adding means” or more generally the process for adding information to an entered image, this is taught by Holmes et al. as a user does not see, for example, the computational process by which bits of an image are changed so that payment information (column 5, lines 25-31) is added to the image. The user only becomes aware of the computer’s actions (e.g. adding means) after the fact such as when the user attempts to access protected content (figure 2). Holmes et al. inherently or at least suggests a computer interface or GUI for entering predetermined information (e.g. credit card number) (column 5, lines 25-28).

Hence, Holmes et al. also teach memory means for storing the predetermined information and inquiry means for sending the information to an external device (e.g. cybercash, credit card, EFT, SET or other remote clearinghouse computer). Regarding the predetermined information, Holmes et al. require a user to re-enter

the information in order to access the protected content (column 6, lines 4-11). Therefore, it is inherent to Holmes et al. or at least Holmes et al. clearly suggest the deletion of the entered payment information. Otherwise, system security and/or user payment information is comprised (column 5, lines 25-28; column 6, lines 4-11 and 51-59). Holmes et al., however, does not specifically recite when the information is deleted. Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would have been obvious to one of ordinary skill to the delete payment information of Holmes et al. after it has been used (e.g. entered into an image) in order to save memory ('076, column 5, lines 45-50) or maintain a secure system by preventing the payment information of previous users to be displayed to new users ('108, column 5, lines 25-31; column 6, lines 51-60).

As per claim 4, Holmes et al. teach a first input means for entering credit card information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32). Holmes et al. do not teach debit card information. However, it is well known to those of ordinary skill in electronic commerce to pay for goods and services using a debit card, therefore, it would have been obvious to allow content consumers to pay for content using a debit card (figure 2).

As per claim 6, Holmes et al. teach outputting content using a computer (figure 2). Computers that control output based on paper size or color are old and well known.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No. 6,460,076 in view of May, U.S. Patent No. 6,021,492.

As per claim 2, Holmes et al. teach a system for protecting content using a communication apparatus (i.e. plug-in embodied in a computer) that controls the use of software on a user computer (column 5, lines 15-53). Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). However, neither Holmes et al. nor Srinivasan specifically recite outputting information to the communication apparatus based on an outputted image. May teaches content protection by limiting the number of access a user has to content (figures 11-14). Specifically, May teaches outputting information to a content control module based on outputted content (figures 10-15; column/line 9/58-11/67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al., Srinivasan, and May in order to allow content creators to allow users to try content before purchasing and to provide users with other

compensatable methods for accessing content other than buying ('492, column/line 9/58-11/52).

7. Claims 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No. 6,460,076 as applied to claim 1 above, and in further view of, Chou et al., U.S. Patent No. 5,337,357.

As per claim 8, Holmes et al. teach a first input means for entering information from said information communication apparatus (column 5, lines 25-32). Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). However, neither Holmes et al. nor Srinivasan specifically recite entering apparatus information. Chou et al. teach a method for protecting content using input information such as an apparatus identifier (abstract; figure 1). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al., Srinivasan and Chou et al. in order to use personal information such as user computer-specific information to protect content ('108, column 5, lines 29-31; '357, figure 1).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Krishnan et al., U.S. Patent No. 6,073,124 and Srinivasan, U.S. Patent No. 6,460,076.

As per claim 13, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)

Regarding “adding means” or more generally the process for adding information to an entered image, this is taught by Holmes et al. as a user does not see, for example, the computational process by which bits of an image are changed so that payment information (column 5, lines 25-31) is added to the image. The user only becomes aware of the computer’s actions (e.g. adding means) after the fact such as when the user attempts to access protected content (figure 2). Holmes et al. inherently or at least suggests a computer interface or GUI for entering payment information (column 5, lines 25-28). Similarly, Holmes et al. require a

user to re-enter the information in order to access the protected content (column 6, lines 4-11). Therefore, it is inherent to Holmes et al. or at least Holmes et al. clearly suggest the deletion of the entered payment information. Otherwise, system security and/or user payment information is comprised (column 5, lines 25-28; column 6, lines 4-11 and 51-59). However, Holmes et al. do not specifically recite a first input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password. Krishnan et al. teach an information communication apparatus comprising:

- a third input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password (figures 14 and 15)
- third output means for outputting said information to an external server (figures 3 and 12; column 19, lines 45-60; column/line 20/64-21/2)
- fourth output means for outputting to an image processing apparatus information on the address of fee billing according to a result of identification on said information on the addressee of fee billing and said password in said external server (figure 12; column 19, lines 63-67)
- fourth input means for entering information and fifth output means for outputting information to said external server (figure 17)

However, neither Holmes et al. nor Krishnan et al. specifically recite when the information is deleted. Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would have been obvious to one of ordinary skill to modify the teachings of Holmes et al., with the authentication method of Krishnan et al. and the payment information processing of Srinivasan in order protect buyers and sellers from fraud ('108, column 5, lines 25-31 and 34-44; column 6, lines 51-60; '124, figures 12-17, column 19, lines 20-67).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

Art Unit: 3621

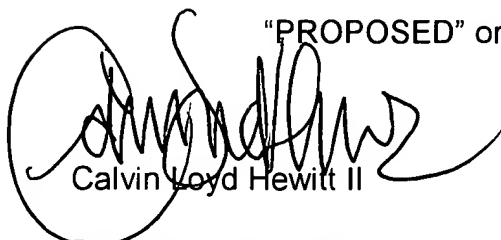
or faxed to:

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over a circular stamp. The signature is fluid and cursive.

Calvin Lloyd Hewitt II

December 22, 2005